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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,428	07/09/2001	Craig M. Whitehouse	840.052.203	8546
4617 7590 06/17/2008 LEVISOHN, BERGER, LLP 61 BROADWAY, 32ND FLOOR NEW YORK, NY 10022				
EXAMINER NGUYEN, KIET TUAN				
ART UNIT 2881		PAPER NUMBER		
MAIL DATE 06/17/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/901,428

**Applicant(s)**

WHITEHOUSE ET AL.

**Examiner**

Kiet T. Nguyen

**Art Unit**

2881

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 99 and 115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 99 and 115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Before any interference may be referred to the BPAI (Board Patent Appeal Interference), applicant must provide information required under 37 CFR 41. 202(a) (1) through (a) (6).

The current application is a continuation of U.S. Patent Application Serial No. 09/676,124 filed on September 29, 2000, which is a continuation of U.S. Patent Application Serial No. 08/694,542 filed on August 09, 1996, **but not is a continuation of U.S. Patent Applications Serial Nos. 09/373,337, 08/794,970, 08/645,826 and 08/202,505.**

Since, the applications are not copending, the benefit claim to the prior-filed application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

#### ***Objected Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **means for providing a delay between the release of the pulses of trapped ions and initiation of pulses in the Time-Of-Flight instrument and means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio** as recited in claims 99 and 115 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Rejection Under 35 U.S.C. 112, First Paragraph***

Claims 99 and 115 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is unclear for reciting the limitations "means for providing a delay between the release of the pulses of trapped ions and initiation of pulses in the

Time-Of-Flight instrument" and "means for adjusting the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio" as recited in claims 99 and 115. Therefore, the Examiner don't understand how is the pulse delayed between the release of the pulses of trapped ions and initiation of pulses in the Time-Of-Flight instrument? And what is the device that is used to adjust the delay to improve the duty cycle efficiency of ions with the second mass to charge ratio?

Additional explanations are needed if applicant insists on including these features in claims 99 and 115 without the introduction of new matter.

***Rejection Under 35 U.S.C. 102(e)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 99 and 115 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chernushevich et al. (6,285,027) for the reasons above. See claim 1 of patent No. 6,285,027.

Applicant's arguments filed on 04-18-2008 have been fully considered but they are not persuasive.

Applicant argued that:

1) The application Ser. No. 09/676,124 is abandoned and is not being relied on for support of the claims.

2) In the interview of April 10, 2008, the Examiner agreed that there is no need to show particular devices for carrying out the method claims 99 and 115.

3) The support for step (e) is found in the specification of current application, page 24, lines 8-10 as "Instead, trapping and the timed release of ions from the multipole ion guide is a preferred method for improving duty cycle"; and page 26, line 6 to page 27, line 5 as " ... timing the release of ion packet 52 from ion guide 16 with the TOF pulse of lenses 34 and 35. A time separate m/z ion packet consisting of subpackets 54 and 56 just before the TOF ion pulse occurs is diagramed in fig. 3".

These arguments are not persuasive. The following are answered for the arguments above:

1) The continuation data as "This application is a CON of 09/676,124 ... 08/202,505 02/28/1994 ABN" must be deleted. Since the application Ser. No. 09/676,124 is abandoned and is not being relied on for support of the claims 99 and 115.

2) In the interview of April 10, 2008, the Examiner did not said that there is no need to show particular devices for carrying out the method claims 99 and 115.

3) The specification of current application is completely silent for supporting the limitations in step (e) of claims 99 and 115. However, Applicant pointed out and interpreted some examples that are relative to the term "delay".

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet T. Nguyen whose telephone number is 571-272-2479. The examiner can normally be reached on Monday-Friday 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on 571-272-2293. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kiet T. Nguyen/  
Primary Examiner, Art Unit 2881